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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,133

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Seiji Takahashi

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EXAMINER

GODBOLD, DOUGLAS

ART UNIT

PAPER NUMBER

2626

NOTIFICATION DATE

DELIVERY MODE

03/20/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/748,133	Applicant(s) TAKAHASHI, SEIJI	
	Examiner DOUGLAS C. GODBOLD	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20040909, 20041216, 20060522</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to application 10/748,133 filed December 31, 2003. Claims 1-14 are pending and have been examined.

Priority

2. This application claims priority to Japanese application 2003-001115 filed January 7, 2003. This priority date has been accepted and considered in this office action. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statements filed September 9, 2004 and December 16, 2004 fail to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

4. The information disclosure statement filed May 22, 2006 has been accepted and considered in this office action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4 and 12 recite the limitation "said plurality of supported languages" in lines 4 and 5 of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 9-14 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example the steps recited in claims 9-14 could be complete by hand and do not require machine intervention to complete. Although hardware is specifically recited in the preamble, these limitations are not given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3, 4, 6-9, 11, 12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Heiny (US Patent 5,778,356).

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11. Consider claim 1, Heiny teaches an information service apparatus for providing information to a terminal connected through a network in accordance with a request sent from the terminal (figure 4), the information service apparatus comprising:

an operation panel on which operation information on said information service apparatus is displayed (figure 4, monitor 116; column 7 line 53);

language correspondence judgment means for judging whether or not the information can be provided in a language designated by discrimination information contained in the request from said terminal (figure 17, user selecting client language, step 403, determination if client language is found; column 15 lines 5-7 and 20-26); and

language determination means for determining the language to be used in providing said information (figure 17, display language selected; column 15 lines 5-36),

wherein, when said language correspondence judgment means determines that said information in the language designated by said discrimination information cannot be provided, said language determination means sets an operation panel language used for displaying said operation information on said operation panel as the language used for providing said information (default language is selected if client language is not available, column 15 lines 26-36.).

12. Consider claim 3, Heiny teaches the information service apparatus as claimed in claim 1, wherein a plurality of languages are supported as the operation panel language so as to use one language previously selected from among the plurality of languages when displaying the operation information on said operation panel (figure 8A and 8B

show a plurality of supported languages that are user selectable; column 13 lines 51- column 14 line 2, also column 8 lines 42- column 9 line 45).

13. Consider claim 4, Heiny teaches the information service apparatus as claimed in claim 1, wherein, when the language designated by the discrimination information contained in the request from said terminal corresponds to neither of said plurality of supported languages, said language correspondence judgment means judges that said information cannot be provided in the language designated by said discrimination information (if no result can be displayed in client or default language, null value is returned; column 15 lines 26-29).

14. Consider claim 6, Heiny teaches the information service apparatus as claimed in claim 1, wherein said information service apparatus is an image processing apparatus (figure 27 for instance shows an image of the system displayed on a screen.).

15. Consider claim 7, Heiny teaches an information display apparatus (figure 4) comprising:

information service request means for sending a send request to an information service apparatus that provides information through a network (knowledge base system on a network, see column 8 lines 6-52), the send request for requesting said information and designating a language used in displaying said information (figure 17, user selected client language, column 15 line 6); and

information display means for displaying said information received from said information service apparatus (figure 4, monitor 116; column 7 line 53),

wherein, when said information service apparatus is incapable of providing said information in the language designated by said information service request means, said information display means displays said information received from said information service apparatus in a language used for displaying information on an operation panel of said information service apparatus (default language is selected if client language is not available, column 15 lines 26-36.).

16. Consider claim 8, Heiny teaches an information service system (figure 4) comprising:

a terminal connected to a network (top portion of figure 4); and
an information service apparatus sending information to said terminal through said network in accordance with a request sent from said terminal (bottom portion 132; knowledge base server),

wherein said information service apparatus comprises:

an operation panel on which operation information on said information service apparatus is displayed (figure 4, monitor 116; column 7 line 53);

language correspondence judgment means for judging whether or not the information can be provided in a language designated by discrimination information contained in the request from said terminal (figure 17, user selecting client language, step 403, determination if client language is found; column 15 lines 5-7 and 20-26); and

language determination means for determining the language to be used in providing said information, wherein, when said language correspondence judgment means determines that said information in the language designated by said discrimination information cannot be provided, said language determination means sets an operation panel language used for displaying said operation information on said operation panel as the language used for providing said information (figure 17, default language is selected if client language is not available, column 15 lines 26-36); and wherein said terminal displays said information in the language determined by said language determination means (figure 17 steps 404 and 407, displaying information in language selected).

17. Consider claim 9, Heiny teaches an information service method for providing information from an information service apparatus to a terminal connected to said information service apparatus through a network in accordance with a request sent from said terminal (figure 17), comprising:

a language correspondence judgment procedure of judging whether or not the information can be provided in a language designated by discrimination information contained in the request from said terminal (figure 17, user selecting client language, step 403, determination if client language is found; column 15 lines 5-7 and 20-26); and

a language determination procedure of determining the language to be used in providing said information (figure 17, display language selected; column 15 lines 5-36),

wherein, when said language correspondence judgment procedure determines that said information in the language designated by said discrimination information cannot be provided, said language determination procedure sets an operation panel language used for displaying said operation information on said operation panel as the language used for providing said information (figure 17, default language is selected if client language is not available, column 15 lines 26-36).

18. Claim 11 is a method requiring similar limitations to the apparatus of claim 3, and is therefor rejected for similar reasons.

19. Claim 12 is a method requiring similar limitations to the apparatus of claim 4, and is therefor rejected for similar reasons.

20. Claim 14 is a method requiring similar limitations to the apparatus of claim 6, and is therefor rejected for similar reasons.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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22. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

23. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiny in view of Seiler, US Patent 7,412,374).

24. Consider claim 2, Heiny teaches the information service apparatus as claimed in claim 1, but does not specifically teach further comprising discrimination information existence judgment means for judging whether said discrimination information is contained in the request from said terminal, wherein said language determination means sets said operation panel language as said language used for providing said information when said discrimination information existence judgment means judges that said discrimination information is not contained in the request from said terminal.

In the same field of language determination, Seiler teaches discrimination information existence judgment means for judging whether said discrimination information is contained in the request from said terminal, wherein said language determination means sets said operation panel language as said language used for providing said information when said discrimination information existence judgment means judges that said discrimination information is not contained in the request from

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said terminal (Figures 6A and 6B show a flowchart for selecting a language, described column 6 lines 35-62. Within this flowchart, determination is made whether each language selection option is present, for instance step 625 described line 33, and if not finds the language information from the next source, step 630 described line 35.).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to deal with missing language information by going onto the next source as taught by Seiler when selecting language information is Heiny in order to properly handle a situation where a user failed to select a client language for a query.

25. Claim 10 is a method requiring similar limitations to the apparatus of claim 2, and is therefor rejected for similar reasons.

26. Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiny in view of Krishnamurthy et al. (Key differences between HTTP/1.0 and HTTP/1.1).

27. Consider claim 5, Heiny teaches the information service apparatus as claimed in claim 1, but does not specifically teach wherein the request from said terminal is a HTTP request, and said discrimination information is a value of an Accept-Language field included in said HTTP request.

In the same field of information retrieval, Krishnamurthy teaches using an HTTP request (abstract and introduction), and with discrimination information being a value of

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an Accept-Language field included in said HTTP request (section 10, content negotiation discusses using “Accept-language” fields to inform servers what languages are acceptable to a user, paragraphs 1 and 5).

Therefore it would have been obvious to one of ordinary skill in the art to use HTTP and “accept—language” as taught by Krishnamurthy in the system of Heiny in order to implement the system of Heiny in a well know and universally accepted protocol language.

28. Claim 13 is a method requiring similar limitations to the apparatus of claim 5, and is therefor rejected for similar reasons.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS C. GODBOLD whose telephone number is (571)270-1451. The examiner can normally be reached on Monday-Thursday 7:00am-4:30pm Friday 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DCG

/Patrick N. Edouard/
Supervisory Patent Examiner, Art Unit 2626